

**REMARKS**

This response addresses those issues raised in the Final Office Action mailed November 23, 2005. Applicant initially would like to thank the Examiner for the careful consideration given to this case and for the courtesy of a telephonic interview held on March 22, 2006. Through the following remarks, Applicant has addressed each and every issue raised by the Examiner in the Office Action. In short, Applicant believes that the Examiner has not set forth a proper *prima facie* case for obviousness, and, additionally, that the proposed combination of references does not teach or suggest the present invention. Applicant believes that each claim is in condition for final allowance, and prompt notice to such effect is respectfully requested.

**March 22, 2006 Interview**

On March 22, 2006, Applicants representative and the inventor, Roger Wood, held a telephonic interview with the Examiner in this case. During this interview, Applicant explained to the Examiner why the two cited prior art references, U.S. Patent No. 6,068,183 to Freeman (“Freeman”) and U.S. Patent No. 6,819,310 to Huang (“Huang”), do not teach or suggest the claimed invention either alone or in combination. In addition to the deficiencies in these references cited by the Examiner in the Office Action, Applicant pointed out additional deficiencies and teachings within these references themselves that counsel away from any combination of these references. The Examiner indicated that he superficially understood the distinctions made by the Applicant, and he indicated that he would consult with an Examiner that has more experience with active reflective bistable displays in order to confirm the Applicant’s assertions (or to counter them). Applicant appreciates the Examiner’s attention to this case in that regard.

**The Prosecution History and The Obviousness Rejection**

The present utility application was filed on February 13, 2001 with 30 claims (device, system and method claims) directed generally to a portable identification device. In the claims, the display was characterized as “an active display enabled for bistable performance.” Such a display necessarily provides all of the advantages that were set forth throughout the specification of the application. This claimed display was not intended to include just any flat display imaginable, but required the display to be both active and bistable.

In the September 17, 2003 Office Action, the Examiner rejected the claims over U.S. Patent No. 5,748,737 to Daggar (“Daggar”). In the Office Action, the Examiner pointed to language in Daggar that it could be merely turned “on” and “off.” The Examiner then argued that on/off are two different states and that this attribute constitutes a “bistable display.” On December 17, 2003, Applicants filed a Response which clearly pointed out that to one of skill in the display art, a display that can be turned on/off is not a bistable display. In actuality, Applicants informed the Examiner, bistable performance requires power only for updating and allows displayed information to be retained without a need for additional power.

In the March 18, 2004 Office Action (a second Non-Final Office Action), the Examiner agreed that the Daggar rejection was improper, and withdrew it. In its place, the Examiner lodged a rejection based upon Freeman, citing two sections of Freeman as teaching “an active display enabled for bistable performance.” Applicant filed a Response on July 19, 2004 pointing out that the cited portions of Freeman do not teach an active display that has bistable performance. In fact, it was shown, Freeman’s use of row/column selector circuitry and other features teach that its described displays were all passive.

An Advisory Action was then sent dated August 26, 2004 stating that Applicant's after-final response would not be entered. However, the case was not after final at that time (only two Non-Final Office Actions had been received). Applicants pointed this out to the Examiner in a September 27, 2004 Response, and the Examiner agreed that the Advisory Action was sent in error.

On March 30, 2005, the Examiner sent out yet another (third) Non-Final Office Action, now with the present Examiner involved in the case. In this Office Action, the Examiner again rejected the claims over Freeman, and the Examiner argued that Freeman does teach active displays (although the Examiner now focused on a different portion of Freeman). On September 7, 2005, Applicant responded and requested an interview for the case. Although Applicant still believes that the claims at that time clearly distinguished over Freeman (for example, the suspended particle displays ("SPDs") of Freeman are based on Brownian movement in a liquid suspension and cannot, by definition, be bistable), in order to move prosecution of this case forward, Applicant amended the display portion of the claims to now include "an active reflective bistable display." Clearly, it was pointed out, the Freeman displays do not teach such a display. The disclosed LCD displays are transmissive or partially transmissive (i.e., transreflective), and the disclosed SPDs and FEDs are similarly constructed. Moreover, even if one or more of these displays could somehow be altered to produce an active reflective bistable display, there is simply no teaching or suggestion within Freeman (or any other reference) to make such an alteration. Without this teaching or suggestion, the rejection is improper. Applicants also demonstrated to the Examiner that the types of displays in Freeman were actually distinguished in the Background of the present specification as old prior art.

In the November 23, 2005 Office Action, the Examiner indicated that Applicant's arguments were persuasive, and the Examiner withdrew the Freeman § 102 rejection (now agreeing that the Freeman displays are passive). However, the

Examiner refused the requested telephonic interview on the grounds that a new rejection (now an “obviousness” rejection) based upon the combination of Freeman and Huang was asserted. The heart of this new rejection is that Freeman teaches all aspects of the claimed invention other than an “active reflective bistable display” and that Huang teaches such a display. However, the mere fact that separate parts of an invention exist separately does not form the proper basis of a § 103 rejection. In fact, Applicant has never asserted that he invented active reflective bistable displays; he did not. But he did invent a novel and non-obvious use for the displays that benefits from some of the unique attributes of these types of displays. In this case, the Examiner’s non-obviousness rejection is improper on its face because he has asserted no valid teaching or suggestion in either reference to combine the teachings of these two patents. In fact, it is clear that Huang and Freeman teach away from each other, and that Huang itself would not be suitable for the Freeman invention, and (more importantly) would not work in the present invention either.

There are a variety of reasons why the Freeman/Huang combination is improper, and each of these will be explored herein. First of all, as stated above, the display described in Huang, as well as similar displays such as those developed by eInk and others (described in the Background of the Invention), have been around since long before the filing of Freeman. One skilled in Freeman’s art would have been aware of these displays, and Freeman specifically chose not to include a display such as Huang in his patent. This is not surprising because Freeman was centered around simple, basic flat displays (such as LCDs and FEDs). These displays are trivial to drive and do not require complicated circuitry and a large amount of hardware/software to operate. Such additional circuitry would not be conducive to the Freeman invention (or the present invention for that matter). The simplicity of the displays disclosed in Freeman therefore teach away from the complicated display and driver circuitry (for fast refresh video) in Huang. It is clear that one skilled in the art, when looking Freeman’s invention, would not look to a complicated video-specific display such as Huang. More importantly, there is no

teaching or suggestion within Freeman or Huang that shows such a connection between the two technologies – a prerequisite to a proper prima facie § 103 rejection. This is fundamental to a proper prima facie case for obviousness, and the Examiner has not shown this here.

Moreover, the Huang reference also teaches away from the applications of the Freeman reference (which require portability). The Huang display is described as being for use in fast-refresh video displays. There is not a single portion of the Huang provisional application that teaches or suggests that it could be altered for use as part of a portable display. The Examiner asserts, as his sole reason why Freeman would look to the Huang display, that col. 13, lines 58-65 teach portability in Huang, creating the link between Freeman and Huang. However, when comparing the Huang provisional patent application (which predates the present application's filing date) and the Huang utility patent application (which was filed after the present application), it is clear that "portable" applications of Huang were not taught until the utility Huang filing – after the filing date of the present invention. Therefore the portions of Huang cited by the Examiner post-date the filing of the present application and cannot be used as the necessary teaching to combine these two references together as required for a prima facie obviousness rejection. Moreover, even though Huang mentions a potential portable application in the utility application, even a fundamental knowledge of the circuitry described in Huang shows that it is wholly unsuitable for such an application and would not operate.

Finally, the Huang display and driver circuitry would not even work with the Freeman invention. The Huang circuitry is far too complicated and bulky to fit in a Freeman-style application. That is why Freeman intentionally ignored this type of display (which was known in the art) in his application. This is also why there is simply no teaching or suggestion to combine these two references, as required for this type of rejection. The Examiner must show something in Freeman

that suggests a reason why these references themselves teach or suggest that they should be combined. As demonstrated above, Huang has no (timely) teaching that is could be used in a portable device like Freeman, and Freeman has no teaching that it could be used with a complicated, bulky display and driver circuitry like Huang to improve refresh rates (which is not even disclosed as a concern within Freeman).

**§ 103 Rejections**

The Examiner rejected Claims 1-2, 5, 7-14, 17-21, 24-25, and 27-30 under 35 U.S.C. 103(a) as being unpatentable over Freeman in view of U.S. Patent Huang. In view of the March 22, 2006 interview and the above remarks, Applicants submit that the current obviousness rejection is improper on its face (a proper prima facie case has not been made), and the claims are in condition for final allowance.

In view of the above claim amendments and remarks, it is believed that the present application is in condition for final allowance and notice to such effect is respectfully requested. If the Examiner believes that additional issues need to be resolved before this application can be passed to issue, the undersigned invites the Examiner, through the attached request for interview, to contact him at the telephone number provided below.

Respectfully submitted,



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Robert D. Kuckler  
Reg. No. 45,908

Dated: May 23, 2006

REED SMITH LLP  
P.O. Box 488  
Pittsburgh, PA 15230-0488  
(412) 288-4598

Attorney for Applicant